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PATENT

Attorney's Docket No. 38827/205276

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Achs et al.
Appl. No.: 09/786,027
Filed: February 28, 2001
For: ENERGY GUIDE CHAIN FOR GUIDING LINES COMPRISING
CHAIN LINKS WHICH CAN MOVE IN THREE DIMENSIONS

June 11, 2001

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Commissioner for Patents
Washington, DC 20231
ATTENTION: Licensing and Review

PETITION FOR RETROACTIVE LICENSE
37 C.F.R. § 5.25

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

1. Petition

Petition is hereby made for a retroactive license under 37 C.F.R. § 5.25 by reason of the unlicensed filing of foreign patent applications which correspond to the above identified U.S. Application No. 09/786,027.

It is believed that this invention is of no interest from a national security standpoint, as it relates to a guide chain for running energy lines between a stationary connection and a movable connection with chain links.

The invention of the above-identified application was invented jointly by Stephan Raymond Achs, an American citizen, and Herbert Wehler and Willibald Weber, both German citizens. Attached hereto is a Declaration by Mr. Achs verifying the circumstances surrounding this petition for a retroactive license. As noted in the Declaration, the inventors' German patent counsel were, as German citizens living and working in Germany, understandably unaware of the U.S. foreign license requirements of 35 U.S.C. § 184. Thus it is clear that the applications were filed abroad through error and without deceptive intent.

2. Identification of Foreign Applications

The unlicensed foreign applications which correspond to the above identified U.S. application are as follows:

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06/14/2001 SLUANG1 0000106245 *ML*

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Appl. No. 09/786,027
Filed February 28, 2001
Page 2



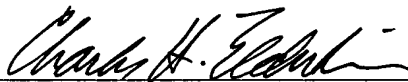
- German Patent Application No. 198 39 575.2 filed August 31, 1998.
- PCT International Application No. PCT/EP99/06373 filed on August 13, 1999 in the European Patent Office.
- Japanese National Phase Patent Application No. 2000-567863 filed February 20, 2001.
- European National Phase Patent Application (designating Germany, France, and Italy) No. EP 9906373 filed February 28, 2001.

The U.S. application as identified above, was also based upon the referenced PCT application.

No further corresponding applications have been filed.

3. Petition Fee

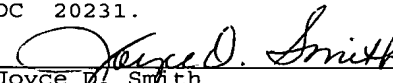
A check in the amount of \$180.00 is attached to cover the required fee (\$1.17(h)).


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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Patents, Washington, DC 20231.


Joyce D. Smith

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GROUP NO.		08-Aug-1978 FILING DATE		09/786.027 SERIAL NO (SERIES OF 1970)	
APPL. <u>INVENTION</u> <u>THAN RAYMOND ACHS, ET AL</u>					
ENERGY GUIDE CHAIN FOR GUIDING LINES COMPRISING CHAIN LINKS WHICH CAN MOVE IN THREE DIMENSIONS					
DRAWINGS	TOTAL CL'S	IND CL'S	FILING FEE REC	TRANSACTION	ATT'Y DK.
Retro: <u>YES</u>					
Expedited: No Docket Number 38827/205276					

PTO-103c
(rev. 6-79)
SECURITY
FILE

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Attorney's Docket No. 38827/205276

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Achs et al.
Appl. No.: 09/786,027
Filed: February 28, 2001
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DIMENSIONS

Assistant Commissioner for Patents
Washington, DC 20231
ATTENTION: Licensing and Review

DECLARATION OF STEPHAN RAYMOND ACHS

I, Stephan Raymond Achs, hereby declare the following:

1. I am a United States citizen residing at 905 N. Bayside Drive, Bayside, Wisconsin 53217.

2. I am currently President of Kabelschlepp America, which is located in Milwaukee, Wisconsin, and is a subsidiary of Kabelschlepp GmbH, a German Corporation located in Siegen, Germany.

3. While employed by Kabelschlepp America, I, along with Mr. Herbert Weber and Mr. Willibald Wehler, made an invention entitled "Energy Guide Chain For Guiding Lines Comprising Chain Links Which Can Move In Three Dimensions," as set forth in the above identified U.S. patent application.

4. Mr. Wehler and Mr. Weber are German citizens, both residing in Germany, and are employees of Kabelschlepp GmbH. The above-referenced invention was made by us jointly while working together on a project to develop an energy chain which would be suitable for a sliding door system of a van. During the development of the invention, Mr. Wehler and Mr. Weber visited me in the

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U.S. to exchange information and ideas, and I visited Kabelschlepp GmbH in Germany to discuss the development.

5. Kabelschlepp GmbH hired German patent counsel to prepare and file patent applications directed to the above referenced invention in several countries, and the following applications were prepared and filed by the German patent counsel:

- German Patent Application No. 198 39 575.2 filed August 31, 1998.
- PCT International Application No. PCT/EP99/06373, filed on August 13, 1999 in the European Patent Office.
- Japanese National Phase Patent Application No. 2000-567863 filed February 20, 2001.
- European National Phase Patent Application (designating Germany, France, and Italy) No. EP 9906373 filed February 28, 2001.

6. At the time the above referenced foreign patent applications were filed, neither I nor my co-inventors were aware of the U.S. requirement for obtaining a foreign filing license according to 35 U.S.C. 184.

7. It is my understanding and belief that at the time the above referenced foreign patent applications were filed, our German patent counsel were not aware of the U.S. requirement for obtaining a foreign filing license according to 35 U.S.C. 184.

8. The invention as disclosed in the above referenced foreign patent applications was not under a secrecy order at the time of those filings, and it is not currently under a secrecy order.

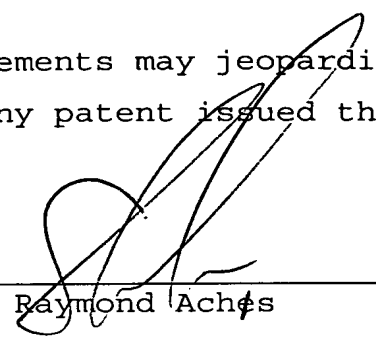
9. It is my understanding and belief that the German patent counsel first became aware of the U.S. foreign filing license requirement when U.S. patent counsel was obtained to handle the U.S. national phase entry of the above referenced PCT International Application, and a letter dated March 15, 2001 was sent by the U.S. patent counsel to our German patent counsel explaining the foreign filing license requirement and requesting information as to whether the invention was made in the U.S. Since that date, our U.S. and German attorneys have exchanged letters to ascertain the circumstances surrounding the development of the invention.

10. The above referenced foreign patent application filings which occurred without first obtaining a foreign filing license from the U.S. authorities occurred through error and without deceptive intent, and I believe that the U.S. and German counsel have made a diligent effort to ascertain the circumstances surrounding the invention and apply for a license as required by U.S. law and regulations.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code

and that such willful false statements may jeopardize the
validity of the application or any patent issued thereon.




Stephan Raymond Achés

Date: 6/7/01

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